

REMARKS

Favorable reconsideration of this application, in view of the present amendments and in light of the following discussion, is respectfully requested.

This amendment is submitted in accordance with 37 C.F.R. § 1.116, which after final rejection permits the entry of amendments canceling claims, complying with any requirement of form expressly set forth in a previous Office Action or presenting rejected claims in better form for consideration on appeal. It is believed that the present amendment places the claims in condition for allowance without requiring further search and/or consideration. Therefore, it is respectfully requested that the present amendment be entered under 37 C.F.R. § 1.116.

Claims 1-12 are pending. Claims 1, 9 and 10 are amended to further clarify the features contained therein. No new matter is introduced.

In the outstanding Office Action, Claims 1-7, 9 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Imamatsu (U.S. Patent No. 6,687,901) in view of Winters (U.S. Patent No. 7,100,011) and Kishimoto (EP 1164476); Claims 8 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Imamatsu, Winters and Kishimoto in further view of Shaw (U.S. Patent No. 6,381,741); and Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Imamatsu, Winters and Kishimoto in further view of Peng (U.S. Patent No. 6,959,436).

Initially, Applicants gratefully acknowledge the courtesy of Examiner Yigdall in holding a personal interview with Applicants' representative on April 14, 2010. During the interview, the outstanding issues in this case were discussed as summarized below and in the Interview Summary, which the Examiner has made of record. Examiner Yigdall could not state whether the arguments presented below are sufficient to overcome the rejections in the outstanding Office Action without further search and/or consideration. Therefore, no agreement was reached.

Furthermore, Applicants respectfully traverse the finality of the outstanding Office Action. The outstanding Office Action asserts that the finality of the rejections is justified because the Kishimoto reference, relied upon to reject Claims 1-7, 9 and 10, was submitted by the Applicants in an IDS filed November 3, 2009. However, MPEP § 609.04(b) provides,

If information submitted during the period set forth in 37 CFR 1.97(c) with a statement under 37 CFR 1.97(e) is used in a new ground of rejection on unamended claims, the next Office action will **not** be made final since in this situation it is clear that applicant has submitted the information to the Office promptly after it has become known and the information is being submitted prior to a final determination on patentability by the Office. (Emphasis added.)

As evidenced in PAIR, the IDS filed November 3, 2009, was filed together with a statement under 37 C.F.R. § 1.97(e). As such, a final Office Action should **not** have been issued for the reasons stated in MPEP § 609.04(b). Therefore, Applications respectfully request the withdrawal of the finality of these rejections.

Turning to the rejection of Claims 1-7, 9 and 10 as being unpatentable over Imamatsu, Winters and Kishimoto, Claim 1 is amended to recite, *inter alia*, a communication terminal including a rewritable non-volatile memory and a rewritable volatile memory, where the communication terminal includes:

means for limiting operation of software using the rewritable volatile memory in response to a received update file information and securing, in response to the received update file information, an area required for storing the update file in the rewritable volatile memory before receiving the update file from a software management server, *the volatile memory being used by the software during normal operation...*(Emphasis added.)

The primary reference, Imamatsu, describes a method for updating software in a radio terminal device (200).¹ Imamatsu describes that the radio terminal device (200) includes a CPU (201), a radio communication unit (205), a main memory unit (202), and a buffer

¹ Imamatsu at column 3, lines 13-34; see also Figure 2.

memory (206).² Further, Imamatsu describes that the memory map of main memory (23) is partitioned into ROM (32), FLASHROM (33), the download buffer (44) and battery backup RAM (34).³ Imamatsu also describes that newly downloaded control-software for the radio terminal device (200) is temporarily stored in the download buffer (44).⁴

However, Imamatsu does not describe that the download buffer (44) is used by software applications in the radio terminal device (200) during normal operation. Instead, Imamatsu describes only that the download buffer (44) is used to store newly-downloaded control-software.⁵ Further, though Imamatsu describes a battery backup RAM (34), Imamatsu only describes that the battery backup RAM (34) is used to store version information for the control-software and to assist in the data transfer *during control-software update*.⁶ Nowhere, however, does Imamatsu describe that either the download buffer (44) or the battery backup RAM (34) are used by software during normal operation. Conversely, amended Claim 1 recites a means for limiting operation of software using the rewritable volatile memory, where the rewritable volatile memory is used by the software during normal operation. Therefore, Imamatsu fails to disclose the claimed means for limiting.

In addition Imamatsu does not describe temporarily storing newly downloaded control software in rewritable volatile memory. In fact, Imamatsu teaches away from storing newly downloaded control software in rewritable volatile memory insofar as Imamatsu describes that should the newly downloaded control-software be lost before the update process is complete, the radio terminal device (200) ceases operation, and “it becomes almost impossible to re-download the update software.”⁷ Conversely, amended Claim 1 recites means for receiving the update file from the software management server, and *storing the*

² Imamatsu at column 3, lines 56-67.

³ See Figure 4A of Imamatsu.

⁴ Imamatsu at column 7, lines 5-20.

⁵ Imamatsu at column 6, line 62-column 7, line 5.

⁶ Imamatsu at column 11, lines 23-49 and column 12, lines 7-26.

⁷ Imamatsu at column 6, line 64-column 7, line 5.

update file in the rewritable volatile memory. Therefore, Imamatsu teaches away from the claimed means for receiving insofar as Imamatsu describes that storage of downloaded control-software in volatile memory can lead to unrecoverable error.

Imamatsu also teaches away from combination with Winters and Kishimoto. Winters describes storing update code received by a cable modem (50) in RAM (54).⁸ Kishimoto describes transferring software stored in D-RAM (24) of an information-processing apparatus (1) to make room for additional software.⁹ Thus, both Winters and Kishimoto describe storing update data in volatile memory. As discussed above, however, Imamatsu teaches away from such storage in volatile memory to avoid unrecoverable error.

A reference may be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 31 U.S.P.Q.2d 1130, 1131 (Fed. Cir. 1994).

One of ordinary skill in the art would be discouraged by Imamatsu from storing update files in rewritable volatile memory to avoid unrecoverable error. Therefore, it is submitted that the features recited in Claim 1 are neither disclosed nor rendered obvious by any combination of Imamatsu, Winters and Kishimoto. Accordingly, amended Claim 1 is believed to be in condition for allowance, together with its corresponding dependent claims.

As Claims 9 and 10 recite features substantially similar to those recited in amended Claim 1, Claims 9 and 10 are also believed to be in condition for allowance, together with any claim depending therefrom, for substantially similar reasons. Accordingly, it is respectfully requested that the rejection of Claims 1-7 and 9-10 under 35 U.S.C. § 103(a) be withdrawn. For the reasons discussed above, no further issues are believed to be outstanding

⁸ Winters at column 6, lines 30-35.


⁹ Kishimoto at paragraphs [0098]-[0101].

in the present application, and the present application is believed to be in condition for formal allowance. Therefore, a Notice of Allowance for Claims 1-12 is earnestly solicited.

Should, however, the above distinctions be found unpersuasive, Applicants respectfully request that the Examiner provide an explanation via Advisory Action under MPEP § 714.13 specifically rebutting the points raised herein.

Respectfully submitted,

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